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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/589,551

06/07/2000

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1115-007U

8542

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7590

09/13/2009

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SUITE 3020

BOCA RATON, FL 33487

EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

09/13/2009

PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* THOMAS L. DISTEFANO, III
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11 Appeal 2009-000339
12 Application 09/589,551
13 Technology Center 3600
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16 Decided: September 13, 2009
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19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

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23 DECISION ON REQUEST FOR REHEARING
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STATEMENT OF THE CASE

The Appellants filed a REQUEST FOR REHEARING on August 17, 2009. The Examiner rejected claims 1-21 in a Non-Final Rejection, mailed June 18, 2007. We affirmed the rejections of claims 1-3 and 7-21 and reversed the rejections of claims 4-6 in our June 16, 2009 Decision. The Appellants seek reconsideration of the decision to affirm these rejections.

We DENY the REQUEST FOR REHEARING.

ISSUES

The issues pertinent to this request are whether the Appellants have sustained their burden of showing that we misapprehended the art or the claims and thus erred in sustaining the rejections of claims, or that we erred in any new grounds of rejection we entered. 37 C.F.R. 41.52(a)(1) and (3).

ANALYSIS

We found the following in our decision:

The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore.

The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

The Appellant had sustained its burden of showing that the Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore.

The Appellant had not sustained its burden of showing that the Examiner erred in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

1 The Appellant had not sustained its burden of showing that the
2 Examiner erred in rejecting claims 14 and 15 under 35 U.S.C. §
3 103(a) as unpatentable over Mason, Moore, and Hess.

4 Decision 16.

5 *Independent Claim 1*

6 Independent claim 1 is directed to a method, whose first step occurs “during
7 design of a first website.” The Appellants argue that we misapprehended the
8 Examiner’s findings and changed the basic thrust of the rejection, essentially
9 making a new ground which the Appellants now ask to argue. The Appellants in
10 particular contend that the Examiner did not find that Mason described the “during
11 design of the first web site” of limitation [1] and expressly found that Mason did
12 not find it so. Thus the Appellants contend that our analysis presented a different
13 thrust from that of the Examiner and was therefore a new ground. Request 4:19 –
14 6:11.

15 We agree that the Examiner did not apply Mason for this claim limitation and
16 we will accept the Appellants’ characterization of our analysis as a new ground in
17 an abundance of caution to afford the Appellants the opportunity to argue our
18 findings as to the design limitation. We found that

19 Mason’s information indicates an advertising marketing element type
20 and specifies a second site location. This information is received at
21 the user interface prior to final approval (FF 10) and is therefore
22 during the design of the website, or at least that particular advertising
23 piece of the second website. The design of any aspect of a web site is
24 a component of the design of the web site itself and thus fits the
25 limitation of occurring during design of the web site.

26 Decision 12:15-21.

27 The Appellants contend that our claim construction is not reasonable and
28 eviscerates any definite meaning from the phrase "during the design of the first

1 web site." Request 6: 9-11. To the contrary, our finding simply equates the
2 process of design to the sum of its parts. The Appellants propose hypothetical
3 design situations that would extend the design time frame back to 300 BC, based
4 on the design of the triangle as a concept, in an advertisement incorporating
5 triangles. This argument is misplaced because it hypothesizes our finding as
6 implying a nonsensical and irrelevant design time frame prior to the beginning of a
7 web site design while the real implication is that design may be an ongoing process
8 that may and realistically often does extend indefinitely in the future, after the
9 beginning of the web site design process.

10 Let us be clear as to what our finding was – that the design of any aspect of a
11 web site, not of parts that might have been designed prior to the beginning of the
12 web site design, is an aspect of the web site design. Thus, none of such aspects as
13 we referred to can begin prior to the start of the concept of designing the web site.
14 But they can continue indefinitely afterward.

15 The Appellant contends that the phrase "during the design of the first website"
16 refers to the duration that starts when a designer makes a definitive step to design
17 the website and ends when the design of the website has been completed. Request
18 7:13-15. We find little to quarrel with in this proffer, but point out that completion
19 may never occur, since design may continue even after a web site is placed in
20 action. To the extent the Appellants may have meant completion of an initial
21 design, or of a particular design version, the claim does not recite that and in any
22 event, would simply substitute the ambiguity of when an design version completes
23 for the ambiguity of when the total design completes.

24 Thus, rather than our finding being unreasonable and eviscerating any definite
25 meaning from the phrase "during the design of the first web site," our finding

1 highlights the breadth of the scope of this temporal limitation. Simply pointing out
2 how broad a limitation is does not eviscerate the limitation. Rather that very
3 breadth might eviscerate the ability of that limitation to actually narrow the claim
4 scope. The choice of the terms used in the claims is that of the Appellants. We
5 simply analyzed the breadth of the terms and how they affected the scope of the
6 claims.

7 As to how our finding applied to the rejection, Mason's description of
8 changing an advertisement on a web site (Decision 6: FF 10) was evidence of a
9 change in the design of the web site containing that advertisement, and thus
10 occurred during the design of the web site. Thus, we find this argument
11 unpersuasive as to error on our part.

12
13 *Independent Claim 8*

14 Independent claim 8 requires selecting a banner ad. We found that a banner ad
15 is simply a link in an HTML document and that Moore described the link and that
16 the contents of the ad attached to a banner ad link are non-functional descriptive
17 material, citing to *In re Ngai*, 367 F.3d 1336,1339.(Fed.Cir. 2004). Decision 9:17-
18 18 and15:22-25.

19 The Appellants argue that our citation to *In re Ngai* constituted a new ground
20 which the Appellants now ask to argue. Request 8:7 – 9:5. We will accept the
21 Appellants' characterization of this as a new ground in an abundance of caution to
22 afford the Appellants the opportunity to argue our findings as to the non-functional
23 descriptive material nature of the contents of a banner ad.

24 The Appellants argue that the claimed banner ad is a type of data structure that
25 includes more than just "simply a link in an HTML document." *Id.* The Appellants

1 argue that banner ads also include a graphical image file and a means to connect
2 the link to a graphical image file, and the banner ad can also be animated, which
3 requires a mechanism to do so or even be interactive with a user input (e.g., a
4 mouse). The Appellants conclude that one skilled in the art would recognize the
5 claimed "banner ad" is a particular type of data structure that includes more than
6 just a link. *Id.*

7 To this argument, we find that the claim makes no reference to animation,
8 interactivity, or user input with a mouse with respect to a banner ad. As to being a
9 data structure, any non-functional descriptive material stored in a computer is a
10 data structure. The issue is whether the data structure has operational
11 functionality. The Appellants pick up on this by citing *In re Lowry*, 32 F. 3d 1579,
12 1583 (Fed. Cir. 1994). The Appellants contend that Lowry's data structures, which
13 according to Lowry greatly facilitate data management by data processing systems,
14 are processed by a machine and are not accessible other than through sophisticated
15 software systems.

16 The Appellants reach the wrong conclusion from this. Lowry's data structure
17 fundamentally altered the processing of the computer; their patentable weight arose
18 not because they were processed by the machine, but because they affected the
19 processing of the computer. Data structures that have no functional relationship
20 with the claimed subject matter are, by definition, non-functional descriptive
21 material. An advertisement, absent explicit incorporation of functional properties,
22 even on a computer display, is non-functional descriptive material.

23 The Appellants argue we failed to give full weight to the meaning of a banner
24 ad. Request 10:19-21. We equated a banner ad to a link attached to non-functional
25 descriptive material. To the extent the link is functional, both we and the

1 Examiner found that Moore's price URL's described the use of such links. The
2 only issue was whether attaching an advertisement, as contrasted with any other
3 descriptive matter such as in Moore, to that link should be afforded patentable
4 weight. We found such did not, citing *In re Ngai*, 367 F.3d at 1339. To the extent
5 the Appellants are arguing that we ignored the link component of a banner ad, our
6 finding as to Moore makes that argument unpersuasive. To the extent the
7 Appellants are arguing that a banner ad may have a functional component aside
8 from its link, the claim does not recite such a functional component, and such a
9 component is not inherent to banner ads per se. Thus, we find the arguments
10 unpersuasive as to error on our part.

11 For the above reasons we are not convinced of reversible error in our
12 decision. Accordingly, the Appellants' request for rehearing is denied.

13 DECISION

14 To summarize, our decision is as follows:

- 15 • We have considered the REQUEST FOR REHEARING
- 16 • We DENY the request that we reverse the Examiner as to claims 1-3 and 7-
17 21.
 - 18 ○ The rejection of claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as
19 unpatentable over Moore remains sustained.
 - 20 ○ The rejection of claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a)
21 as unpatentable over Mason and Moore remains sustained.
 - 22 ○ The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable
23 over Mason and Moore remains not sustained.

- The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler remains sustained.
- The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess remains sustained.

DENIED

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